

Appl. No. 09/709,162
Reply to Office Action of July 14, 2005

Docket No. MGH-046PUS

REMARKS

Applicants respectfully request the Examiner to reconsider and again examine the claims in view of the following remarks.

Claims 1 - 67 are pending in the application. No claims are presently allowed and no claims have been amended or cancelled by this amendment. In accordance with the revised provisions of 37 C.F.R. §1.121(c) as enacted on July 30, 2003, a copy of the claims is provided hereinabove.

The Examiner objected to the drawings. Applicants are in the process of having drawing FIG. 1 revised per the Examiner's suggested correction and will submit the corrected drawing in due course.

The Examiner rejected claims 1, 26, 27, 32-35, 48, 55, 56, 59, and 60 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-16 of U.S. Patent No. 6,134,003 (the '003 patent) in view of U.S. Patent 5,801,826 (the '826 patent) issued to Williams.

Applicants submit that this rejection is improper and should be removed. Before consideration can be given to the issue of double patenting (either statutory or nonstatutory-type double patenting) there must be some common relationship of inventorship and/or ownership of two or more patents or applications (see MPEP §804). With respect to the Williams patent, there is no such common relationship of inventorship and/or ownership and thus the Williams patent cannot be used in this rejection.

The Examiner rejects Claims 48, 50 and 51 under 35 U.S.C. §102(b) as being anticipated by U.S. Patent number 5,454,807 issued to Lennox (the '807 patent).

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Applicants would like to remind the Examiner that to sustain a rejection under 35 U.S.C. §102, a single reference must disclose each and every element of the claimed invention. In this case, the Lennox reference neither describes nor suggests a multifiber catheter having at least one imaging fiber and at least one therapeutic light energy delivering fiber as called for in Claim 48. The Lennox reference describes a conduit constructed to deliver a flow of coolant from a source of the coolant to a surface of the selected tissue volume through which the light energy passes in reaching a volume.

Claims 50 and 51 each depend from and thus include the limitations of claim 48. Thus, claims 50 and 51 are patentably distinct over the Lennox reference generally for the reasons discussed above in conjunction with claim 48.

Applicants submit that claim 50 is further patentable over the Lennox reference since the Lennox reference fails to call for an arrangement in which an imaging fiber and an energy delivering fiber are coaxial. In one embodiment of Lennox, the conduit is located coaxially around the optical fiber. Lennox neither describes nor suggests a multifiber catheter in which an imaging fiber and an energy delivering fiber are coaxial as called for in claim 50.

In view of the above, Applicants submit that Claims 48, 50 and 51 are patentably distinct over the Lennox reference.

The Examiner rejects claims 49, 52 – 54 under 35 U.S.C. §103(a) as being unpatentable over Lennox ('807).

Claim 49 and 52-54 each depend from and thus include the limitations of claim 48. Thus each of claims 49 and 52-54 call for a multifiber catheter having at least one imaging fiber and at least one therapeutic light energy delivering fiber. As discussed above, Lennox neither describes nor suggests a multifiber catheter having at least one imaging fiber and at least one therapeutic light energy delivering fiber. Thus, Applicants submit that claims 49 and 52-54 are patentably distinct over the Lennox reference.

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The Examiner rejects claims 1-65 under 35 U.S.C. §103(a) as being unpatentable over Boppart et al. (U.S. Patent No. 6,485,413) in view of Williams.

As the Examiner is aware, and as found in MPEP §2142, in order to establish a prima facie case of obviousness "...there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings." Applicants respectfully submit that the Examiner has not met this burden in order to establish prima facie obviousness.

Neither the Boppart nor the Williams reference describe or suggest any reason as to why the references should be combined as suggested by the Examiner. More importantly, perhaps, neither has the Examiner. Applicants have not taken the position that they have invented a dispersive element. Applicants have taken the position that claims 1-65 define useful, new and non-obvious a combination involving a dispersive element. The Examiner has merely used Applicants application as a template to combine the references and formulate the rejection. There is no evidence of record in this case which suggests combining the Boppart and Williams references as suggested by the Examiner.

Moreover, the Examiner still apparently maintains the position that a transmission line is a dispersive element. This line of reasoning is clearly incorrect as pointed out in prior responses in this case.

In view of the above, Applicants submit that the rejection of claims 1-65 under 35 U.S.C. §103(a) as being unpatentable over the combination of Boppart et al. and Williams is clearly improper and should be removed and such action is respectfully requested.

The Examiner rejects claims 66 and 67 under 35 U.S.C. §103(a) as being unpatentable over Boppart et al. (U.S. Patent No. 6,485,413) in view of Williams ('826) and further in view of Benja-Athon ('502).

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As discussed above, there is no suggestion found in the prior art or provided by the Examiner as to why one of ordinary skill in the art would seek to modify Boppart with Williams and thus this combination is clearly improper. Since the combination of Boppart and Williams is improper, it is also improper to add Benja-Athon to this combination.

In view of the above, Applicants submit that the rejection of claims 66 and 67 under 35 U.S.C. §103(a) as being unpatentable over the combination of Boppart et al., Williams and Benja-Athon is clearly improper and should be removed and such action is respectfully requested.

In view of the above amendment and remarks, Applicants submit that claims 1-67 and the entire case are in condition for allowance and should be sent to issue and such action is respectfully requested.

The Examiner is respectfully invited to telephone the undersigning attorney if there are any questions regarding this Amendment or this application.

The Assistant Commissioner is hereby authorized to charge payment of any additional fees associated with this communication or credit any overpayment to Deposit Account No. 500845.

Dated: 17 JAN 06

Respectfully submitted,

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